

REMARKS/ARGUMENTS

This Amendment is in response to the Office Action mailed December 22, 2006. In the Office Action, claims 1, 4 and 9-13 stand rejected under 35 U.S.C. § 112, claims 1 and 14 stand rejected under 35 U.S.C. § 102, and claims 4, 9-13, 17, and 22-26 stand rejected under 35 U.S.C. § 103.

Applicant has amended independent claims 1 and 14 to further clarify embodiments of the invention.

Reconsideration in light of the amendments and remarks made herein is respectfully requested.

Rejection Under 35 U.S.C. § 112

Claims 1, 4, and 9-13 stand rejected under 35 U.S.C. § 112, second paragraph, as being allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Applicant has amended independent claim 1 to recite “the security computing device”. Applicant respectfully submits that this amendment overcomes the Office Action’s § 112 rejection.

Applicant respectfully requests that the Examiner withdraw the rejection of claims 1, 4, and 9-13 under 35 U.S.C. § 112, second paragraph.

Rejection Under 35 U.S.C. § 102 and § 103

Claims 1 and 14 stand rejected under 35 U.S.C. § 102(b) as being allegedly anticipated by U.S. Patent No. 6,026,293 issued to Osborn (hereinafter Osborn). Further, claims 4, 9-13, 17, and 22-26 stand rejected under 35 U.S.C. § 103(a) as being allegedly obvious by Osborn in view of what would allegedly have been known to one of ordinary skill in the art at the time of the invention.

Utilizing amended independent claim 1 as an example, Applicant has amended independent claims 1 and 14 such that they both generally include limitations generally related to a system and method for uniquely identifying a security computing device that is coupled to a computer comprising: *the security computing device being separate from the computer and adapted for connection by a user to the computer with an input/output (I/O) connector...* wherein when the computer attempts to log on to the server over the computer network...the security computing device having a processor and a secure memory under the control of the processor computes a response as part of a challenge-response process with the server and computes a response based upon the user key stored in the secure memory of the security computing device such that if the server receives a response to the challenge that matches the expected response, *the server allows the computer to log on to the server...and based upon a request from the computer for an asset, the server to encrypt an asset with an asset key and to encrypt the asset key with the user key of the security computing device and to send the encrypted asset and asset key to the computer.*

MPEP § 2131 provides:

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference.” *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). ... “The *identical invention* must be shown in as complete detail as contained in the ... claim.” (Emphasis added). *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim.

Applicant respectfully submits that amended independent claims 1 and 14 are not anticipated by the Osborn because Osborne does describe the elements of amended independent claims 1 and 14.

In the previous Office Action, the Examiner primarily relies on the Background Section of the Osborn reference as being allegedly relevant to the claims.

The Examiner cites Figure 1 of the Background Section of Osborn for showing a prior art cellular communication network. Further, the Examiner relies on the Background Section of

Osborn for describing a first prior art process of comparing an electronic serial number from a memory of a cell phone and a second prior art process describing a challenge-response method for a cell phone that utilizes a user key. (See generally Osborn, column 2, line 50 – column 3 line 35, emphasis added).

Even more particularly, on pages 4-5 of the previous Final Office Action, the Examiner states that because Osborn discloses a cell phone (allegedly equivalent to security computing device) and a base station (allegedly equivalent to server) connected through a network (which the Examiner alleges that by definition includes a group of separate computers) that a computer is also disclosed. In essence, the Examiner appears to equate a cell phone with the security computing device of Applicant's claims, a base station as equivalent to the server of Applicant's claims, and random computers of the cellular network as being equivalent to the computer of Applicant's claims.

Applicant respectfully disagrees with the Examiner's characterizations, but even assuming *arguendo* that they were valid, Applicant respectfully submits that Osborn still does not describe or suggest the limitations of Applicant's amended independent claims which recite a *security computing device that is separate from and adapted for connection by a user to a computer with an input/output (I/O) connector* and wherein the *separate security computing device includes a processor and a secure memory to effectuate challenge-response functionality with a server...to allow the computer to log on to the server*. These limitations are quite simply not described or suggested by Osborn.

The fact that Osborn allegedly discloses a network of computers still in no way describes or suggests utilizing a separate security computing device that is adapted for connection by a user to the computer with an input/output (I/O) connector.

In particular, Applicant respectfully submits that the first process of comparing an electronic serial number from a memory of a cell phone as part of a first process (see generally, Column 3, lines 1-7) and the other prior process of a challenge-response method for a cell phone that utilizes a user key (see generally, Column 3, lines 21-35), either alone or in combination with the rest of the Osborn reference, do not describe or suggest the limitations of Applicant's

amended independent claims 1 and 14 that generally relate to: *a security computing device that is separate from a computer and that is adapted for connection by a user to the computer with an input/output (I/O) connector...wherein...the separate security computing device includes a processor and a secure memory to accomplish challenge-response functionality... to allow the computer to log on to the server.*

Applicant respectfully submits that Osborn is related to a completely different invention and quite simply does not describe or suggest these limitations.

Moreover, Applicant has amended independent claims 1 and 14 to include limitations from dependent claims 10 and 23, respectively, generally related to: *...that based upon a request from the computer for an asset, the server is to encrypt an asset with an asset key and to encrypt the asset key with the user key of the security computing device and to send the encrypted asset and asset key to the computer.*

In the previous Office Action, the Examiner took Official Notice that it is allegedly well known to send encrypted content with an encrypted key and that these limitations would have been obvious to one of ordinary skill in the art. Applicant respectfully submits that this Official Notice is unfounded and that it would not have been obvious to one of ordinary skill in the art at the time of the invention that based upon a request from a computer for an asset, a server encrypts an asset with an asset key and encrypts the asset key with a user key of a separate security computing device that is adapted for connection by a user to the computer with an input/output (I/O) connector and to then send the encrypted asset and asset key to the computer. Applicant respectfully submits that the use of a separate security computing device for this purpose is novel and non-obvious.

As set forth by the Federal Circuit, reliance merely on “common knowledge” and “common sense” does not fulfill the PTO’s obligation to cite references to support an obviousness conclusion, as the PTO must document its reasons on the record to allow accountability and effective appellate review. In re Lee 61 USPQ2d 1430, 1435 (Fed. Cir. 2002). If the Examiner disagrees with the Applicant, in accordance with MPEP § 2144.03, Applicant respectfully requests that references be supported in support of the Examiner’s position.

Thus, because Osborn does not describe or suggest the limitations of Applicant's amended independent claims 1 and 14, Applicant respectfully requests that the Examiner allow these claims and pass them to issuance. Further, as to the claims that depend from the independent claims, Applicant respectfully requests that the Examiner likewise allow these claims and pass them to issuance.

Conclusion


In view of the remarks made above, it is respectfully submitted that pending claims 1, 4, 9-14, 17, and 22-26 are allowable over the prior art of record. Thus, Applicant respectfully submits that all the pending claims are in condition for allowance, and such action is earnestly solicited at the earliest possible date. The Examiner is respectfully requested to contact the undersigned by telephone if it is believed that such contact would further the examination of the present application. To the extent necessary, a petition for an extension of time under 37 C.F.R. is hereby made. Please charge any shortage in fees in connection with the filing of this paper, including extension of time fees, to Deposit Account 02-2666 and please credit any excess fees to such account.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Dated: 4/20/2007

By


Eric T King
Reg. No. 44,188
Tel.: (714) 557-3800 (Pacific Coast)

Attachments

12400 Wilshire Boulevard, Seventh Floor
Los Angeles, California 90025

CERTIFICATE OF MAILING/TRANSMISSION (37 CFR 1.8A)

I hereby certify that this correspondence is, on the date shown below, being:

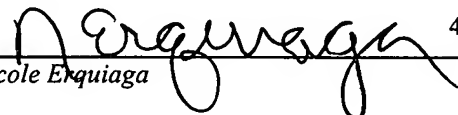
MAILING

☒ deposited with the United States Postal Service
as first class mail in an envelope addressed to:
Commissioner for Patents, PO Box 1450,
Alexandria, VA 22313-1450.

Date: 4/20/2007

FACSIMILE

☐ transmitted by facsimile to the Patent and
Trademark Office.


Nicole Erquiaga
4/20/2007
Date